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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TSAI, CAROL S W

ART UNIT

PAPER NUMBER

2857

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/927,545	<b>Applicant(s)</b> SCHLEMM, PETER	
	<b>Examiner</b> CAROL S. TSAI	<b>Art Unit</b> 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 5,987,224 to Koakutsu et al.

4. With respect to claim 1 and 9, Koakutsu et al. disclose a method of executing method steps with an apparatus controlling a printing press (printer 2 shown on Fig. 3B), the method which comprises: connecting the apparatus (control unit 28 shown on Fig. 3B) to an input unit (on-line /off-line selector (not shown)); enabling the apparatus for switching an error mode on or off via the input unit (see Abstract, lines 8-9 and col. 7, lines 1-23); checking whether the error mode is switched on via the input unit (see col. 13, lines 40-46); and producing an output signal in a method step and outputting the output signal as at least one of an optical or an acoustic signal if the error mode is switched on and not outputting the output signal if the error mode is not switched on (see col. 13, lines 46-52).

5. As to claim 2, Koakutsu et al. also disclose the method steps being divided into modules, and the method comprising changing from one module to another module during the execution of the method steps, and wherein the output signal comprises an identifier (indicator 15 shown 3 B) (see col. 5, lines 56-67) indicating in which module the output signal was produced (see col. 6, lines 35-63).

6. As to claims 3 and 11, Koakutsu et al. also disclose executing the method steps in a plurality of devices (host device 1, host interface 25, control unit 28, data buffer 27, and switch signal 35 from switch 14 shown on Fig. 3B), and generating the output signal with an identifier indicating the device in which the output signal was produced (see col. 14, lines 19-33).

7. As to claims 4, 5, 6, 12, and 13, Koakutsu et al. also disclose the method steps being stored as digital data in a storage device (data buffer 27 shown on Fig. 3B) (see col. 6, lines 26-42), and the method comprising reading out the method steps from the storage device and executed the method steps (see col. 12, lines 39-49), and wherein the output signal comprises an identifier indicating where the method step is stored that produced the output signal (see Figs. 4, 9, and 10 and col. 12, line 50 to col. 13, line 37 and col. 14, lines 1-52).

8. As to claim 7, Koakutsu et al. also disclose outputting the output signal via an output unit (indicator 15 shown on Fig. 3B) (see col. 13, lines 49-52).

9. As to claim 8, Koakutsu et al. also the output signal being stored in a storage device, together with an indication of a time at which the output signal was stored (see col. 14, lines 34-60).

10. As to claims 14 and 15, Koakutsu et al. also disclose the location being identified in said storage device via a memory address (see col. 12, lines 39-46).

11. As to claim 16, Koakutsu et al. also disclose input means configured to enable selective switching on and switching off of the output mode even during the execution of the method steps (see col. 12, lines 14-28).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,987,224 to Koakutsu et al.

14. As noted above, Koakutsu et al. disclose the claimed invention, except for a second control apparatus, and wherein one of said first and second control apparatus produces the output signal, and said first or second control apparatus outputs the output signal if an output mode is switched on, and the output signal comprises an identifier indicating whether the output signal was produced by said first or second control apparatus.

15. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to duplicate a second control apparatus, and wherein one of said first and second control apparatus produces the output signal, and said first or second

control apparatus outputs the output signal if an output mode is switched on, and the output signal comprises an identifier indicating whether the output signal was produced by said first or second control apparatus, in order that the printing apparatus and control method can be configured to process a variety of tasks simultaneously to improve the processes required to replenish consumable printing materials consumed during the printing operation. Further, as shown in *St. Regis Paper Co. v Bemis Co.* 193 USPQ 8 (7th Cir. 1977), to duplicate parts for multiple effects generally does not provide patentable weight to the claimed invention.

### ***Response to Arguments***

16. Applicant's arguments filed September 4, 2008 have been fully considered but they are not persuasive.

17. Applicant argues that Koakutsu et al. do not disclose the apparatus being enabled for switching an error mode on or off via an input unit. The Examiner disagrees with Applicant. As set forth in the art rejection above, Koakutsu et al. do disclose the apparatus being enabled for switching an error mode on or off via an input unit (see Abstract, lines 8-9 and col. 7, lines 1-23; When operation of switch 14 is detected, the function assigned to switch 14 in that operating state is executed. When the end of roll paper 10 is detected by paper-end sensor 29, control unit 28 interrupts the printing process and therefore stops reading data from data buffer 27 to control unit 28. To prevent data loss resulting from the host device 1 continuing to supply command and print data exceeding the storage capacity of data buffer 27 at this time, the printer 2

**goes off-line to disable data receiving.** *This off-line status is thus posted to the host device 1 using printer status data 40).* **"the word `error mode` for the indication that an item of error information is concerned"** as described at page 20, lines 17-18 of Applicant's Specification, applicant clearly describes that error mode means an item of error information being concerned. Koakutsu et al. disclose if paper-out signal (output signal is produced) is detected (see S61 shown on Fig. 4) indicating there is no more roll paper loaded (in error mode), then the control unit switches to the off-line state (see Fig. 4 shown below and col. 7, lines 24-38) and a "Waiting for paper fee LED3" is on (an optical or acoustic signal) (the output signal is outputted) to indicate the output signal is in error mode (see S62 shown on Fig. 4); otherwise, if the paper-out signal (the output signal is produced) is not detected (see S61 shown on Fig. 4), then processing go to block "END" (the output signal is not outputted) (see END block shown on Fig. 4). Therefore, Koakutsu et al. do disclose the apparatus being enabled for switching an error mode on or off via an input unit.

U.S. Patent

Nov. 16, 1999

Sheet 5 of 11

5,987,224

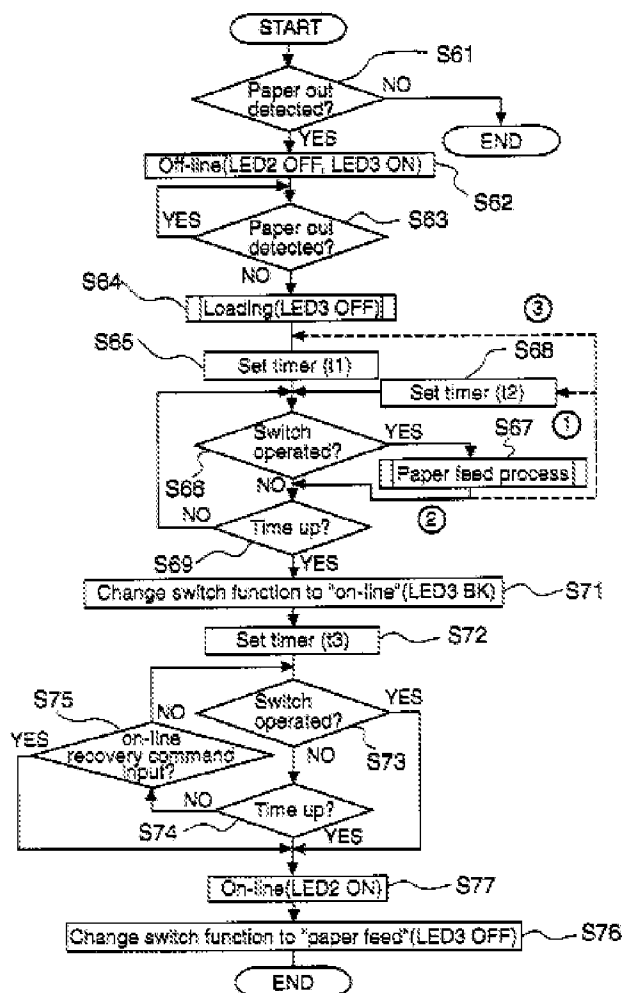


FIG. 4

18. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by



combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Koakutsu et al. disclose the claimed invention, except for a second control apparatus, and wherein one of said first and second control apparatus produces the output signal, and said first or second control apparatus outputs the output signal if an output mode is switched on, and the output signal comprises an identifier indicating whether the output signal was produced by said first or second control apparatus, in order that the printing apparatus and control method can be configured to process a variety of tasks simultaneously to improve the processes required to replenish consumable printing materials consumed during the printing operation. Further, as shown in *St. Regis Paper Co. v Bemis Co.* 193 USPQ 8 (7th Cir. 1977), to duplicate parts for multiple effects generally does not provide patentable weight to the claimed invention.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2857

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAROL S. TSAI whose telephone number is (571)272-2224. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ramos-Feliciano S. Eliseo can be reached on (571) 272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 27, 2008

Art Unit 2857

/Carol S Tsai/

Primary Examiner, Art Unit 2857